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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,341	04/22/2005	Kurt Frimann Berg	BERG3	1525
1444 7590 02/17/2009 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
SOLOLA, TAOFTQ A				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
02/17/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,341

Applicant(s)

BERG, KURT FRIMANN

Examiner

Taofiq A. Solola

Art Unit

1625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,3,5-27,58-71,74-78 and 81-109 is/are pending in the application.
- 4a) Of the above claim(s) 74-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1,3,5-27,87-90 and 98 is/are allowed.
- 6) ☐ Claim(s) 58-71,81-86,91-97,99-109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date na.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Claims 1, 3, 5-27, 58-71, 74-78, 81-109 are pending in this application.

Claims 2, 4, 28-57, 72-73, 79-80 are cancelled.

Claims 74-78 are non-elected.

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.117(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/1/08 has been entered.

Response to Restriction

The restriction of claims 74-78 is sustained because the invention does not relate to composition of claim 1. The restriction of claims 58-71, 81-83 is now withdrawn, and the claims are rejoined with the elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 58-71, 81-83, 99-109 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims lack adequate support in the specification.

Claims 58-59, 81-83 are drawn to the treatment of all clinical conditions or symptoms, known today and those that may be discovered in the future. There is no known composition as one-size-fits all in medicine, no support thereof in the instant specification, and such is not a practical utility under the US patent practice. To ascertain the practical utility one must read the specification into the claims contrary to several precedent decisions by the US courts and the Office practice. Even then, the claims would become duplicates of claims 60-71. Under the US patent practice, duplicate or substantial duplicates claims cannot be in the same application. In patent examination, it is essential for claims to be precise, clear, correct, and unambiguous. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir.1989). A claim must stand alone to define the invention, and incorporation into the claims by reference to the specification or an external source is not permitted. Ex parte Fressola, 27 USPQ 2d 1608, BdPatApp & Inter. (1993). By deleting claims 58-71, 81-83 the rejection would be overcome.

There is no conclusive evidence that the instant composition would treat bacteria or viral infection listed in claims 62, 65 and 67. The specification disclosure is limited to testing rhinovirus. Therefore, Applicant must provide evidence that any composition effective against rhinovirus is effective against the listed bacteria and viruses either by biological assay or scientific journals showing biological assay published by independent investigators prior to the filing of this application.

In respect of claims 99-109, the specification fails to identify the "identical composition," by whom, when made and evidence of comparative assays between the instant composition and the "identical composition," performed in support of the claimed superior activities. Even then, the claimed activities are inherent properties of claim 1. By deleting claims 62, 65, 67, 99-109 the rejection would be overcome.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 84-86, 91-97, 99-109 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 84-86, 91-93 cite inherent properties of claim 1. Purified menthol is used in claim 1. Also, the listed impurities are found in Peppermint oil, which is not a component of the instant composition. Therefore, the impurities are inherently absent from claim 1. The claimed activities in 94-109 are inherent properties of claim 1. Therefore, claims 84-86, 91-97, 99-109 are substantial duplicates of claim 1. Under the US patent practice, duplicate or substantial duplicates claims cannot be in the same application. By deleting claims 84-86, 91-97, 99-109 the rejection would be overcome.

Allowable Subject matter

Claims 1, 3, 5-27, 87-90, 98 are allowable over prior arts of record.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

/Taofiq A. Solola/

Primary Examiner, Art Unit 1625

February 12, 2009